

REMARKS

As a preliminary matter, Applicant would like to express appreciation to Examiner Pryor for conducting a personal interview with Applicant's representative on August 22, 2006. During the interview, agreement was reached that the "applied art does not teach or suggest the claimed method comprising temporarily incapacitating formulations." *See* Interview Summary. The phrase "temporarily incapacitating formulation" is recited in the body of independent claim 34, but neither disclosed in nor reasonably suggested by the applied art.

Claims 34-47 and 52-60 are pending in this application. Claims 53-60 have been added. Each of the new claims is supported by the original disclosure. Claims 53 and 55 are supported at page 12, lines 21-22. Claims 54 and 56 are supported at page 12, line 22 to page 13, line 2. Claim 57 is supported at page 1, lines 12-13. Claim 58 is supported at page 1, lines 13-17. Claim 59 is supported at page 2, lines 20-22. Claim 60 is supported at page 13, lines 10-16. Accordingly, approval and entry of the new claims are respectfully requested.

Claims 34-44, 46, 47, and 52 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,286,475 to Louvet et al. in view of U.S. Patent Application Publication No. 2004/0167046 to Lukenbach et al. and U.S. Patent No. 5,804,203 to Hahn et al.

Applicant respectfully traverses this rejection.

Independent claim 34 recites a method for incapacitating a subject, in which a non-lethal temporarily incapacitating formulation suitable for use in an aerosol or spray application is directed into the facial area of the subject. The incapacitating formulation comprises an incapacitating agent, and a solvent system comprising a mixture of propylene glycol esters of short chain fatty acids and glycerol tris (2-ethylhexanoate).

As explained in Applicant's response of July 19, 2004, the word "incapacitating" is a term of art. The specification provides various examples of what is meant and encompassed by the recitation of "incapacitating" of a recipient of the formulation. Persons skilled in the art would have readily understood that incapacitating formulations of the type described in the specification and claimed are intended for uses such as self-defense and law enforcement, such as in the cases of bar fights, domestic disturbances, hostage and terrorist situations, riot, fleeing suspects, and barricaded individual.

Applicant respectfully submits that the rejection is based on an inaccurate premise, and in particular the Examiner's characterization of Hahn as follows:

The amount of fragrance (incapacitating agent) taught in the reference is enough to cause sufficient inflammation to disable the recipient since the amount of fragrance disclosed in the prior art falls within the range of incapacitating agent disclosed in instant claim 46.

(Office Action, page 4)

Applicant respectfully submits that the cosmetic fragrances disclosed in the applied art are not incapacitating agents, as that term is used in the present application and would be understood to a person skilled in the art. The fragrances of the type disclosed in the applied art are cosmetics applied to the skin, not directly into the eyes and nose. As applied to the skin, such fragrances might cause skin irritations, but would hardly rise to the level of causing temporary incapacitation of the subject. A person of ordinary skill in the art would not confuse the minor skin irritation of a cosmetic with the much disabling effect of an incapacitating formulation. For these reasons alone, the Section 103(a) rejection should be withdrawn.

Applicant further respectfully submits that the present claims recite not only an "incapacitating agent," but that the agent is part of an "incapacitating formulation." Even

accepting, for the sake of argument, that the fragrances of the cited art are incapacitating agents, which argument Applicant refutes, each of the applied documents teaches modifying its cosmetic formulation to minimize or eliminating the irritating effect of its alleged agent. Hahn in particular discloses that its topical formulation includes “an anti-irritant amount” of aqueous-soluble strontium cation. The irritating effect that otherwise would be imposed by Hahn’s alleged incapacitating agents is negated by the use of the strontium cation. The formulation, as a whole, is described as “particularly useful for preventing, reducing or eliminating the potential irritation.” (Column 9, lines 56-58) The Hahn formulation does not incapacitate. The other documents, i.e., Louvet and Lukenbach, are similarly deficient. Louvet discloses that its foam composition “is very pleasant in application and is easily eliminated when water is applied to the face.” (Column 8, lines 23-25) Lukenbach discloses that its cleansing composition includes non-inflammatory agents, and is “non-irritating” and “suitable for use by people with sensitive skin and eyes.” Clearly, the formulations of Louvet, Hahn, and Lukenbach do not qualify as incapacitating formulations, as agreed upon by the Examiner during the interview.

For these additional reasons, Applicant respectfully submits that independent claim 34 is not rendered obvious by Louvet, alone or in combination with Hahn and Lukenbach. Applicant further respectfully submits that claims 35-47 and 52-60, being dependent from claim 34 and incorporating all of the distinguishing features thereof, are patentable for the reasons advanced above and for the additional reason that the added subject matter of the dependent claims is neither disclosed in nor reasonably suggested by the applied art. Examples of several of these dependent claims and their limitations which are not taught by the applied art are described in detail below.

Dependent claim 35 recites that the non-lethal temporarily incapacitating formulation is sprayed into the eyes of the subject. None of the cited documents discloses spraying their respective compositions into the eyes. Cosmetics such as those described in the cited documents are conventionally applied to the hands, and then applied to the facial and eye area for safety and comfort reasons. A person does not intentionally spray cosmetics into his or her eyes. Further, eye-care cosmetics of the type described in the cited documents are not applied into the eyes, but to the skin area surrounding the eyes for cosmetic purposes.

Dependent claim 47 recites that the incapacitating agent constitutes about 1.4% to about 1.5% by weight of the solvent system. Dependent claim 60 recites that the incapacitating agent constitutes at least 0.9% by weight of the solvent system. These features are not disclosed in the applied art, which uses a much lower concentration of fragrance. Louvet for example teach 0.2-0.5% fragrance, as pointed out at page 3, lines 1-2 of the Office Action. Hahn reports a fragrance “exemplary” weight percent of 0.10, preferably 0.01-0.2 at column 40, line 48. It appears that Lukenbach does not disclose the use of fragrance in its composition.

Dependent claim 52 recites that the incapacitating formulation is formulated to cause, upon application of the system to the facial area of a recipient, sufficient inflammation to temporarily disable the recipient. As explained above, the cited art discloses formulations which minimize or eliminate inflammation such that the recipient would not be temporarily disabled.

Dependent claim 53 recites that is non-lethal temporarily incapacitating formulation causes the subject to experience immediate closing of the eyes, shortness of breath, and/or burning sensation. Dependent claim 55 recites that all of these symptoms are experienced by the recipient of the incapacitating formulation. As explained above, the cited art expressly teaches

the reduction or elimination of irritating effects. No mention is made that their formulations cause closing of the eyes, shortness of breath, or burning sensations.

Dependent claim 57 recites the step of defending oneself by directing the non-lethal temporarily incapacitating formulation into the facial area of the subject. A person caught in a situation requiring self-defense to ensure his or her safety would not pull out and apply cosmetics to his or her assailant.

Dependent claim 58 recites that the non-lethal temporarily incapacitating formulation is directed into the facial area of a person engaged in a bar fight, a domestic disturbance, a hostage situation, a terrorist situation, a barricade situation, a riot, or to a fleeing suspect. Again, these are not situations dictating the use of a cosmetic. Nor does the applied art describe the use of its formulations for these situations.

Dependent claim 59 recites that the non-lethal temporarily incapacitating formulation is applied by a law enforcement official into the facial area of the subject. As explained above, cosmetics are not intended for situations involving law enforcement.

For these additional reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103 rejection.

Claims 34, 35, 39-47, and 52 have been rejected under 35 U.S.C. § 103(a) as obvious over Hahn in view of Lukenbach.

Applicant respectfully traverses this rejection.

The deficiencies of Hahn and Lukenbach vis-à-vis independent claim 34 are expressed above in detail. Applicant respectfully submits that the reshuffling of the order of the cited documents and the elimination of Louvet from the rejection does not detract from these shortcomings. Neither Hahn nor Lukenbach discloses nor reasonably suggests a non-lethal,

temporarily incapacitating formulation as that term would be understood in the art and as the term is used in the specification. Even accepting, *arguendo*, that the chemicals disclosed in Hahn are inflammatory agents, which Applicant refutes, Hahn teaches that the inflammatory effect of the agents on the skin of an individual is reduced or eliminated by the use of strontium cations. Lukenbach teaches that its product likewise is a non-irritant and non-inflammatory.

For these reasons, Applicant respectfully submits that independent claim 34 is not rendered obvious by Hahn in combination with Lukenbach. Applicant further respectfully submits that claims 35-47 and 52-60, being dependent from claim 34 and incorporating all of the distinguishing features thereof, are patentable for the reasons advanced above and for the additional reason that the added subject matter of the dependent claims is neither disclosed in nor reasonably suggested by the applied art. The specific arguments presented above regarding dependent claims 35, 47, 52, 53, 55, and 57-60 are incorporated by reference as part of the remarks in response to the Section 103 rejection of Hahn in combination with Lukenbach. Reconsideration and withdrawal of the rejection are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule the same.

Respectfully submitted,

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